UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/672,136	VAIDYANATHAN ET AL.
	Examiner	Art Unit
	Janice A. Mooneyham	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _18 May 2005_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _49-71_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _49-71_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This is in response to the applicant's communication filed on May 18, 2005,

wherein:

Claims 49-71 are currently pending;

Claims 49, 52, 53, 55, 58, 61-63, and 65 have been amended;

Claims 66-72 have been added.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 18,

2005 has been entered.

Claim Objections

3.   Claim 69 is objected to because of the following informalities:

The applicant has grammatical errors. The applicant has "a electronic

marketplace" which should read "an electronic market place".   The applicant has the

"transaction data describe transactions" It should read "data describes". Appropriate

correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claims 49-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 49 and 58 the applicant is claiming a system and method, comprising:

Providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, *wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace;*

Electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute;

Utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

In claims 51and 60, the applicant claims a method and system that *automatically initiates enrollment* of the sellers within the dispute resolution system in response to the request.

In claim 52, the applicant claims a method and system wherein the online dispute resolution system electronically communicates the status information *to a database of the electronic marketplace.*

In claim 53, the applicant claims the online dispute resolution system further comprising a server to *service electronic requests issued by a server within the electronic marketplace to exchange data between the online dispute resolution system and the electronic marketplace.*

In claim 54, the applicant claims a data manager software application to automatically communicate data between a database of the online dispute resolution system and *a database of the electronic marketplace.*

In claim 55, applicant claims the dispute resolution system electronically communicating *rating data from a database of the online dispute resolution system to a database of the electronic marketplace.*

In claim 61, the applicant claims a method comprising electronically communicating data that relates to the online dispute resolution process *to the database of the electronic marketplace, and updating the electronic marketplace based on the data received from the dispute resolution system.*

In claim 62, the applicant claims *automatically* controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.

In claim 63, the applicant claims *without manually entering the transaction data into the dispute resolution system.*

In claim 64, the applicant claims wherein the online dispute resolution system receives *an electronic query from the marketplace.*

In claim 65, the applicant claims receiving with the online dispute resolution system an electronic query from the electronic marketplace and electronically providing a status associated with one of the users from a database of the online dispute resolution system *to the database of the electronic marketplace* in response to the query.

In claim 66, the applicant claims *a software application to automatically communicate transaction data from a database of the electronic marketplace to a database in the system in response to a transaction within the electronic marketplace.*

In claim 67 the applicant claims wherein *the electronic marketplace stores transaction data that describes transactions within the marketplace and automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute and*

Utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

In claim 68 applicant claims *storing transaction data in an electronic marketplace,*
wherein the transaction data describes the transaction within the electronic
marketplace, receiving case information with an online dispute resolution system,
wherein the case information describes a dispute related to one of the transactions of
the electronic marketplace, *automatically communicating at least a portion of the*
transaction data related to the dispute from the electronic marketplace to the online
dispute resolution system without manual intervention and executing a dispute
resolution process with the online dispute resolution system *that utilizes the transaction*
data from the electronic marketplace and the case information form the parties to assist
the users in resolving the dispute.

In claim 69, applicant claims *storing transaction data in a database of an*
electronic marketplace, wherein the transaction data describes transactions with the
electronic marketplace, receiving case information with an online dispute resolution
system from one or more parties, where the case information describes a dispute
related to one of the transaction of the electronic marketplace and executing a dispute
resolution process with the online dispute resolution system *that receives at least a*
portion of the transaction data stored from the database of the electronic marketplace
without human intervention in response to initiation of the dispute and uses the received
portion of the transaction data and the case information form the parties to assist the
parties in resolving the dispute.

In claim 70, the applicant claims *an electronic marketplace system including a*
database and software object that automatically communicates transaction data from

the database to the online dispute resolution system when transactions within the electronic marketplace are performed by members of the online dispute system, wherein the online dispute resolution system executes a dispute resolution process that utilizes the transaction data and the dispute information *to assist the parties in resolving the dispute.*

In claim 71, the applicant claims *an electronic marketplace system including a database that stores transaction data that describe transactions for buyers and sellers, a software object executing the electronic marketplace system that automatically communicates the transaction data form the database to the online dispute resolution system without human intervention in response to initiation of a dispute,* and a software object executing within the electronic marketplace system that queries the database of the online dispute resolution system for status for at least one user of the electronic marketplace system.

In claim 72, the applicant claims an online dispute resolution system having at least one server that communicates *with a database of an electronic marketplace system without human intervention in response to initiation of a dispute.*

The applicant amended the claims and added new claims. On page 12 of the remarks, the applicant states that no new matter has been added by the new claims and support for the new claims can be found throughout the present specification, including for example, [0046]-[0048]. The Examiner has reviewed these sections and does not find support for the new claims.

The Examiner is unable to find support for the italicized portions of the claim language in the original disclosure as stated by applicant in the remarks section accompanying the amendment on March 11, 2004. Therefore, the Examiner request that the applicant specifically direct the Examiner to the portions of the specification where there is support for this claim language.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant claims a software application to communicate transaction data "in response to a transaction within the electronic marketplace *by a member the online dispute resolution.*" This is unclear. It appears there may be a typo.

Claim 68 recites the limitation "the parties". There is insufficient antecedent basis for this limitation in the claim.

Claim 68 recites the limitation "the users". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 49-61 and 64-71 are rejected under 35 U.S.C. 102(e) as being

anticipated by Collins et al (US 2002/0007362) (hereinafter referred to as Collins).

Referring to Claims 49, 52-58 and 64:

Collins discloses method and system, comprising:

providing an online dispute resolution system (*Figure 7b Welcome to DISPUTE*

RESOLUTION, INC; [0004-0005] method and system for facilitating agreement

pertaining to a situation over a network; [0037]) comprising a server (*Figures 1a and 1b*

(120)), a data manager software application for communicating data between databases

(*col. 8, claim 9 a computer program product for use on a computer system for facilitating*

agreement comprising code for receiving data, storing data, and retrieving data) and

least one database (*Figures 1a and 1b (140) (160)*), the online dispute resolution

system electronically coupled to an electronic marketplace that provides a website by

which users buy and sell items (*(Figure 1b and [0045] Party B is a merchant that*

maintains records concerning customers; [0039] a customer may have a dispute with a

merchant. The dispute may arise in connection with a transaction occurring over the

Internet; [0047] if the method is used for dispute resolution in connection with goods

sold by a merchant over the Internet), wherein the electronic marketplace includes a

database that stores transaction data that describes transactions within the marketplace

(*Figure 1b (160) [0045] Party B has an attached database 160. Party B is a merchant that maintains records concerning customers. Data which may be maintained includes the number of transaction that the customer has had with the merchant, the amount of merchandise purchased, an associated rating of the customer and any other data perceived of as pertinent by the merchant concerning the customer*);

electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute (*[0045] the associated rating of the customer provides a mechanism for the corresponding server process to select the level that the customer should begin resolution; the server process, having data concerning the customer as provided by the merchant's database, would grant the customer's request base upon the rating; also see [0047]*);

utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace (*[0045] if the customer has a high rating which indicates the loyalty of the customer as represented by the number, volume, or value of purchases the merchant may with to bypass the computer negotiation phase and move directly to level two or three. Additionally, this customer rating may allow the customer with a high rating to select the resolution mechanism; also see [0047]*).

Referring to Claims 50 and 59:

Collins discloses electronically receiving with the online dispute resolution system communications from the users of the electronic marketplace to initiate filing of disputes;

and initiating the online dispute resolution process in response to the communications

(*Figures 2 and 3 and [0046-0047] Figure 2 (300) initialization or registration stage; (400)*

issue definition and clarification).

Referring to Claims 51 and 60:

Collins electronically receiving with the online dispute resolution system

enrollment requests from the sellers of the marketplace and initiating enrollment of the

sellers within the dispute resolution system in response to the requests (*Figure 7a and*

7b and [0054] and [0061] terms and conditions of use may be supplied to the first party;

if party indicates agreement, registration data is obtained).

Referring to Claim 61:

Collins discloses a method further comprising electronically communicating data

that relates to the online dispute resolution process to the electronic marketplace and

updating the electronic marketplace based on the data received from the dispute

resolution system (*[0042] A initiates negotiation by contacting the central server 120*

and providing data to the server concerning the situation; Party B is contacted and

sends position data over the network to the central server; Based on information

provided, server generates zone of possible agreement and renders it to the parties).

Referring to Claim 65:

Collins discloses a method comprising the online dispute resolution system

receiving a query and electronically providing a status associated with the user (*[0047]*

Eligibility status).

Referring to Claims 66 and 67:

Collins discloses a method and system, comprising:

providing an online dispute resolution system (*Figure 7b Welcome to DISPUTE RESOLUTION, INC; [0004-0005] method and system for facilitating agreement pertaining to a situation over a network; [0037]*) comprising a server (*Figures 1a and 1b (120)*), a data manager software application for communicating data between databases (*col. 8, claim 9 a computer program product for use on a computer system for facilitating agreement comprising code for receiving data, storing data, and retrieving data*) and least one database (*Figures 1a and 1b (140) (160)*), the online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items (*(Figure 1b and [0045] Party B is a merchant that maintains records concerning customers; [0039] a customer may have a dispute with a merchant. The dispute may arise in connection with a transaction occurring over the Internet; [0047] if the method is used for dispute resolution in connection with goods sold by a merchant over the Internet*), wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace (*Figure 1b (160) [0045] Party B has an attached database 160. Party B is a merchant that maintains records concerning customers. Data which may be maintained includes the number of transaction that the customer has had with the merchant, the amount of merchandise purchased, an associated rating of the customer and any other data perceived of as pertinent by the merchant concerning the customer*)

automatically communicating the transaction data stored to the online dispute

resolution system without human intervention in response to initiation of a dispute

(*[0045] the server process, having data concerning the customer as provided by the*

merchant database; see also [0047]); and

utilizing the transaction data in accordance with a dispute resolution process to

assist the users in resolving disputes relating to the transactions within the electronic

marketplace (*[0045] if the customer has a high rating which indicates the loyalty of the*

customer as represented by the number, volume, or value of purchases the merchant

may with to bypass the computer negotiation phase and move directly to level two or

three. Additionally, this customer rating may allow the customer with a high rating to

select the resolution mechanism; also see [0047]).

Referring to Claim 68:

Collins discloses a method, comprising:

storing transaction data in an electronic marketplace, wherein the transaction

data describes the transaction within the electronic marketplace (*[0045] Figure 1b (160)*

Party B has attached database 160; Party B is a merchant that maintains records

concerning customers which includes the number of transactions, etc);

receiving case information with an online dispute resolution system, wherein the

case information describes a dispute related to one of the transactions of the electronic

marketplace (*[0043] negotiation log file (150) all communications between the parties*

and the central server process, as well as communications between the parties may be

captured and recorded in the negotiation log file 150 [0046] and Figure 2 Step 400

involves issue definition and clarification; see [0047] Figure 3 position data; [0061 case

reference number allows the parties to access case information including negotiation

log throughout the negotiation process);

automatically communicating at least a portion of the transaction data related to

the dispute form the electronic marketplace to the online dispute resolution system

without manual intervention ([0045] *[0045] the server process, having data concerning*

the customer as provided by the merchant database; see also [0047]); and

executing a dispute resolution process with the online dispute resolution system

that utilizes the transaction data from the electronic marketplace and the case

information from the parties to assist the users in resolving the dispute (*[0045] rating of*

customer provides mechanism for server process to select level that customer should

begin resolution [0047] Figure 3 first party introduced to system; first party provides

position data; determine if the party is eligible; if eligible, second party invited to

participate; a Negotiation Log file is created).

Referring to Claim 69:

Collins discloses method, comprising:

storing transaction data in a database of an electronic marketplace, wherein the

transaction data describes transactions with the electronic marketplace (*[0045]Figure 1b*

(160) Party B has attached database 160; Party B is a merchant that maintains records

concerning customers which includes the number of transactions, etc).

receiving case information with an online dispute resolution system from one or

more parties, where the case information describes a dispute related to one of the

transaction of the electronic marketplace (*[0047] position data*); and

executing a dispute resolution process with the online dispute resolution system

that receives at least a portion of the transaction data stored from the database of the

electronic marketplace without human intervention in response to initiation of the

dispute and uses the received portion of the transaction data and the case information

form the parties to assist the parties in resolving the dispute (*[0045] rating of customer*

provides mechanism for server process to select level that customer should begin

resolution [0047] Figure 3 first party introduced to system; first party provides position

data; determine if the party is eligible; if eligible, second party invited to participate;.

Referring to Claim 70:

Collins discloses a system, comprising:

a system that presents an interface (*Figures 1a and 1b (110)*);

an electronic marketplace system (*Figure 1b*) including a database (*160*) and

software object that automatically communicates transaction data from the database to

the system (*[0045-0047]*).

Referring to Claim 71:

Collins discloses system comprising:

a first system having a database (*Figures 1a and 1b (140)*);

a second electronic system including a database, software object executing with

the second electronic system that automatically communicates transaction data from

the database to the first system (*Figure 1b (160) and [0045-0047]*); and

a software object executing with the second system that queries the database

(*Figures 1a and 1b server process; claim 9 computer program product with code*).

Referring to Claim 72:

Collins discloses a system comprising:

a server (*Figures 1a and 1b (server process)*);

a plurality of client computers (*Figures 1a and 1b (110)*);

a system having at least one server that communicates with a database of an

electronic marketplace system (*Figure 1b (server process and (160)*).

6.   Claims 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Collins.

Referring to Claim 62:

Collins discloses a pull down box provided with a listing of possible participating

parties such as merchants and companies which allows the customer to know whether

the merchant/other party is bound to participate [0061].

Collins does not disclose displaying in the electronic marketplace visual indicia

associated with users of the electronic marketplace that participate in the dispute

resolution system and automatically controlling the appearance of the visual indicia as a

function of data received from the dispute resolution system for the users in response to resolution of the disputes.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to display visual indicia because applicant does not disclose that the indicia is used for a particular purpose other than what it means to the mind of one viewing the indicia or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention with the pull down box disclosed in Collins or the indicia because both are used to notify a customer whether the merchant is a participating with the dispute resolution system

Therefore, it would have been an obvious matter of design choice to modify Collins to obtain the invention as specified in claim 62.

Referring to Claim 63:

Collins does not disclose method comprising embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website of the electronic marketplace to enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace.

However, the Examiner takes Official Notice that it is old and well known to provide a URL within a website to enable users to access another system as is evidenced by Yahoo. Google, and the PTO website, all having hyperlinks to other sites.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the dispute resolution system of Collins a URL locator on participants' websites so a user can easily and quickly access the system.

Response to Arguments

Applicant's arguments with respect to claim 49-65 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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